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09/742,862	12/20/2000	Jonathan Spetner	7727	7603

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POLSTER, LIEDER, WOODRUFF & LUCCHESI  
763 SOUTH NEW BALLAS ROAD  
ST. LOUIS, MO 63141-8750

EXAMINER

GARCIA, ERNESTO

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,862

Applicant(s)

SPETNER ET AL.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1, 3, 7, 9, 11, 16, 18 and 19 are objected to because of the following informalities:

regarding claim 1, a comma should be inserted before "comprising" in line 1, the limitation "the Internet" in line 1 should be --an Internet--, the limitation "screen" in line 5 should be --screens--, the limitation "a" in line 9 before "user" and "representative" should --the--;

regarding claims 3 and 11, the limitation --further-- should be included after "system" in line 1;

regarding claims 7, 16 and 18, the limitation "a" in line 1 should be --the--;

regarding claim 9, a comma should be inserted before "comprising" in line 1, the limitation "the Internet" in line 1 should be --an Internet--; and,

regarding claim 18, the limitation "goods and services" in line 3 is contradictory to "goods or services" in line 5;

regarding claim 19, the limitation "a" in line 1 before "representative" and "a" in line 2 before "customer" should --the--. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 1, the applicants are claiming a telephone connection between a user and a representative in lines 8-9 of claim 1. Therefore, claim 1 is positively claiming the user and the representative. Claiming a person is non-statutory. A solution is to make the connection between the computer and the computer system.

Regarding claim 9, claiming a customer and a representative in line 14 is non-statutory. A solution would be to functionally further describe the telephone connection as being able to allow a customer and a representative to be able to talk.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "once the telephone connection has been established" in line 12 is unclear whether there is a telephone connection after all since lines 8-9 indicate a telephone connection is present between the computer and the computer system.

Regarding claims 2-7, the claims depend from claim 1 and therefore are indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Agostino, 5,231,571.

Regarding claim 1, D'Agostino discloses a system comprising a computer **14**, a computer system **12**, a telephone connection **16** between the computer **14** and the computer system **12**. The computer system **12** further comprises a means **72** for controlling operation of the computer **14**.

Regarding claims 2 and 10, the means **72** for controlling comprises a software program (col. 11, lines 15-18).

Regarding claims 3 and 11, the computer system **12** further comprises a software program **70** (col. 11, lines 6-9).

Regarding claims 4 and 12, the vendor computer system **12** comprises a computer having a display **44**.

Regarding claims 6 and 14, the computer is a hand held computer.

Regarding claim 7, a representative is capable of inputting information to be displayed on the computer capable of accessing an Internet.

Regarding claims 8 and 17, the computer system **12** further comprises a computer having a display **44** having a first window which is representative of a screen

Art Unit: 3679

provided to the computer and a second window containing other information (col. 13, line 68 to col. 14, line 2).

Regarding claim 9, Regarding claim 1, D'Agostino discloses a system comprising a customer computer **14**, a customer telephone **30A**, a vendor computer system **12**, a vendor telephone **52**, a telephone connection **16** between the customer telephone **30A** and the vendor telephone **52**. The computer system **12** further comprises a means **72** for controlling operation of the customer computer **14**.

Regarding claim 15, the customer computer **14** is a wireless hand held computer. Applicant is reminded that Figure 2A shows no wires therefore being wireless.

Regarding claim 16, a representative is capable of inputting information to be displayed on the customer computer **14**.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino, 5,231,571.

Regarding claims 5 and 13, D'Agostino, as discussed above, discloses the telephone connection **16** not being wireless connection. Applicant is reminded that wireless connections have been known for years. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to convert the telephone connection **16** into a wireless connection.

Claim 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford, 5,724,424, in view of D'Agostino, 5,231,571.

Regarding claim 18, Gifford discloses a method of marketing goods and services over an Internet comprising:

- providing a website of a vendor over the Internet;
- allowing a customer to access the website to view screens relating to goods or services offered by the vendor; and,
- displaying the goods or services. However, Gifford fails to disclose connecting a telephone call between the customer and a representative of the vendor and conferencing the customer and the representative together for the representative to control operation of the screens presented to the customer.



Applicant is reminded that connecting a telephone call between the customer and a representative of the vendor is well known as websites often place customer service phone number for obtaining assistance on how to operate the screens presented to the customer. Furthermore, D'Agostino teaches conferencing a customer and representative together for the representative to control operation of the screens presented to a customer for displaying services to a customer while allowing one-to one human interaction between a customer and a representative (col. 3, lines 53-57; col. 4, lines 9-18). Therefore, as taught by D'Agostino, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include conferencing the customer and the representative together for the representative to control operation of the screen presented to the customer as conferencing allows displaying service to a customer while allowing one-to-one human interaction between the customer and the representative.

Regarding claim 19, D'Agostino discloses the method further includes the representative inputting information to be presented to the customer.

Regarding claim 20, Gifford teaches the method further includes finalizing a purchase of the goods or services.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

  
**Lynne H. Browne**  
**Supervisory Patent Examiner**  
**Technology Center 3600**

E.G.

June 2, 2003